



NEIFELD DOCKET NO: OBSP5GARD-USC2

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: WILL GARDENSWARTZ

USPTO CONFIRMATION CODE: 5962

SERIAL NO: 09/893,775

FILED: 6/29/2001

EXAMINER: Donald Champagne

GROUP ART UNIT: 3622

FOR: Communicating with a Computer Based on the Offline Purchase History of a Particular Consumer

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 41.37 APPEAL BRIEF

Sir:

In response to the non-final office action mailed February 27, 2006, the applicants appeal.

05/31/2006 JADD01 00000135 09893775

02 FC:1402

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I. **37 CFR 41.37 (a)**

This brief is filed with the notice of appeal under 41.31 and is accompanied by the fee set forth in 37 CFR 41.20(b)(2), and sets forth the authorities and arguments on which the appellant will rely to maintain the appeal.

II. **37 CFR 41.37 (b)**

The filing is timely – within three months of the office action mailed February 27, 2006. Accordingly, this subsection is not relevant.

III. **37 CFR 41.37 (c)(1)**

A. **37 CFR 41.37 (c)(1)(i) Real Party in Interest**

The real party in interest is Catalina Marketing International, Inc., a Delaware corporation, which is wholly owned by Catalina Marketing Corporation, a Delaware corporation.

B. **37 CFR 41.37 (c)(1)(ii) Related Appeals and Interferences**

There are no related appeals or interferences. Accordingly, this section is inapplicable.

C. **37 CFR 41.37 (c)(1)(iii) Status of Claims**

Claims 1 and 55-87 are pending. Claims 1 and 55-87 are rejected and under appeal.

D. **37 CFR 41.37 (c)(1)(iv) Status of Amendments**

All amendments are entered.

E. **37 CFR 41.37 (c)(1)(v) Summary of Claimed Subject Matter**

The invention of claim 1 is a method for delivering a targeted advertisement, comprising: receiving from a first computer a first identifier identifying the first computer (page 4 lines 21-23) and associated by a purchase behavior classification with an observed offline purchase history of a consumer (page 4 lines 23-25; page 15 lines 6-8), said purchase history including purchase history information of an offline purchase of a consumer collected when the

offline purchase transpired (page 15 lines 24-28); and selecting and electronically delivering the targeted advertisement to the consumer at the first computer in response to receiving the first identifier from the first computer, said selecting based on said purchase behavior classification without providing to an advertiser any of said purchase history information, wherein said offline purchase was not transacted with the first computer (page 15 lines 10-12; page 21 lines 4-8).

The invention of claim 55 is a computer network implemented method for delivering targeted advertisements, comprising: collecting, during an offline purchase transaction of a first consumer, a first consumer offline purchase history data and a first customer identification for said first consumer (page 15 lines 17-13; page 15 line 29 to page 16 line 4; Figure 6); storing said first consumer offline purchase history data in association with said first consumer identification (page 15 lines 24-28); receiving from a consumer computer a first identifier (page 16 lines 12-22); associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data (page 17 lines 20-27); determining a targeted advertisement for said first consumer based at least in part on said offline purchase history associated via said first consumer identification with said first identifier (page 19 line 26 to page 20 line 3); and delivering said determined targeted advertisement to said first consumer (page 21 lines 4-5).

The invention of claim 86 is a computer network system for delivering targeted advertisements, comprising: structure for collecting, during an offline purchase transaction of a first consumer, a first consumer offline purchase history data and a first customer identification for said first consumer (page 15 lines 17-13; page 15 line 29 to page 16 line 4; Figure 6); structure for storing said first consumer offline purchase history data in association with said first consumer identification (page 15 lines 24-28); structure for receiving from a consumer computer a first identifier (page 16 lines 12-22); structure for associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data (page 17 lines 20-27); structure for determining a targeted advertisement for said first consumer based at least in part on said offline purchase history associated via said first consumer identification with said first identifier (page 19 line 26 to page 20 line 3); and structure for delivering said determined targeted advertisement to said first consumer (page 21 lines 4-5).

The invention of claim 87 is a computer network system for delivering targeted advertisements, comprising: means for collecting, during an offline purchase transaction of a first consumer, a first consumer offline purchase history data and a first customer identification for said first consumer (page 15 lines 17-13; page 15 line 29 to page 16 line 4; Figure 6); means for storing said first consumer offline purchase history data in association with said first consumer identification (page 15 lines 24-28); means for receiving from a consumer computer a first identifier (page 16 lines 12-22); means for associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data (page 17 lines 20-27); means for determining a targeted advertisement for said first consumer based at least in part on said offline purchase history associated via said first consumer identification with said first identifier (page 19 line 26 to page 20 line 3); and means for delivering said determined targeted advertisement to said first consumer (page 21 lines 4-5).

**F. 37 CFR 41.37 (c)(1)(vi) Grounds of Rejection to be Reviewed on Appeal**

Whether the rejection of claim 1 under 35 USC 103(a) as being obvious over Biorge et al. (USP 5,806,045, hereinafter “Biorge”) in view of Stein et al. (USP 5,459,306, hereinafter “Stein”) and Herz et al. (USP 5,754,938, hereinafter “Herz”) is improper and should be reversed.

Whether the rejections of claims 55, 56, 62-69, 72, 86, and 87 under 35 USC 102(b) as obvious over Stein in view of Merriman et al. (USP 5,948,061, hereinafter “Merriman”) are improper and should be reversed.

Whether the rejections of claims 57-61, 71, and 73-85 under 35 USC 103(a) as obvious over Stein, based on the examiner’s official notice, are improper and should be reversed.

Whether the rejection of claim 70 under 35 USC 103(a) as obvious over Stein in view of Merriman and further in view of De Lapa et al. (USP 6,076,068, hereinafter “de Lapa”) is improper and should be reversed.

G. **37 CFR 41.37 (c)(1)(vii) Argument**

1. **The Rejection of Claim 1 Under 35 USC 103(a) as Being Obvious Over Biorge in View of Stein and Herz is Improper and Should be Reversed**

In support of the 35 USC 103(a) rejection of claim 1 over Biorge et al. (USP 5,806,045 hereinafter “Biorge”) in view of Stein et al. (USP 5,459,306 hereinafter “Stein”) and Herz et al. (USP 5,754,938 hereinafter “Herz”), the examiner stated that:

4. Biorge et al teaches a method for delivering *incentive credits*, which reads on targeted advertising, comprising: receiving from a first computer (*the portable device*) a first identifier (*encrypted signals*) identifying the first computer, and associated with an observed offline purchase history of a consumer, including purchase information collected when the purchase transpired, and selecting and electronically delivering the credits/targeted advertising to the consumer at the first computer in response to receiving the first identifier (col. 5 lines 2-3 and 23-29). The credits in the first computer are derived from and therefore associated with an observed offline purchase history of a consumer.

5. Biorge et al. also teaches that some offline purchases, which reads on said offline purchase, are not transacted with the first computer. A “purchase” is an exchange for money or its equivalent (Merriam-Webster’s Collegiate Dictionary). The first computer is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to transact the purchase.

6. Biorge et al. does not teach that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (*user code*, col. 2 lines 65-

66) is associated by a purchase behavior classification with the observed purchase history of a consumer (col. 2 line 66 to col. 3 line 8). Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al.

7. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history.

8. Applicant argues, (p. 14-15) that Biorge et al. does not teach determining a targeted ad based on the consumer's offline purchase history. The *incentive credit* (col. 1 lines 38-49 and col. 5 line 27) is the ad because it advertises the *participating provider* (col. 1 lines 48-49). It is targeted at the specific customer (col. 2 line 21). It is based on the user's purchase history (previous *purchase transactions*, col. 1 lines 38-44). At least some of said previous transactions are offline because the reference teaches *most transactions may be conducted off-line* (col. 2 lines 35-36).

9. Applicant argues (p. 16-18) that there is no motivation to combine Stein et al. with Biorge et al. because the classification information is irrelevant to the purpose of Biorge et al. The justification for combining the references is the statistical efficiency of classification (para. 6 above). Applicant argues that Biorge et al. deals only with "credit information" (e.g., at p. 17 lines 2-3 from the bottom, and col. 18 line 2). Actually, Biorge et al. deals with *incentive credits*, which is to say promotional discounts (col. 5 lines 27-29). Classification would be helpful if, for example, the sponsor was interested in providing said credits to all consumers shopping in a particular pharmacy chain, or in a particular geographical region.



10. Applicant argues (p. 18-19) that there is no motivation to combine Herz et al. with Biorge et al. because Biorge et al. does not disclose or suggest categorizing a consumer based on product selections. While true, that is irrelevant. The justification for combining the references is maintaining confidentiality of the purchase history data (para. 7 above), said data being collected in Biorge et al. (col. 6 lines 38-44). The data are available for abuse, for example revealing to sponsor Walgreen that the customer routinely shops at competitor CVS. Herz et al. teaches making the targeted ad/credits selection so as to prevent this abusive disclosure of customer data. [Office action mailed February 27, 2006 page 2 line 21 to page 4 line 10; emphasis supplied in the original.]

In response, the applicant asserts that the examiner's rejection of claim 1 -- that Biorge in view of Stein and Herz discloses the limitations of claim 1 -- are improper for the following reasons.

**2. The Examiner's Rejection of Claim 1 is Improper Because Biorge Does not Disclose "said offline purchase was not transacted with the first computer", as Recited in Claim 1**

In support of the rejection of claim 1, the examiner stated that:

**5. Biorge et al. also teaches that some offline purchases, which reads on said offline purchase, are not transacted with the first computer.** A "purchase" is an exchange for money or its equivalent (Merriam-Webster's Collegiate Dictionary). The first computer is used to transact an offline purchase only when credits are available (on the first computer) and used to pay at least part of the purchase price. The reference teaches (col. 5 lines 29-33) that presently accrued credits are not applicable to present purchases. Hence, when the only credits available are presently accrued credits, the first computer is not used to

transact the purchase. [Office action mailed February 27, 2006 page 2 line 29 through page 3 line 5; emphasis supplied.]

In the office action mailed February 27, 2006 at page 2 line 22, the examiner stated that:

comprising: receiving from a first computer (*the portable device*) a first identifier

The examiner thereby asserts that the portable device (customer-carried portable device 74) disclosed in Biorge is equivalent to the first computer, as claimed in claim 1. More specifically, the examiner asserts that Biorge's portable device 74 is not used in offline transactions when no available credits are stored on the device 74 and therefore meets claim 1's recitation that "said offline purchase was not transacted with the first computer".

In response, the applicant asserts that Biorge does in fact disclose that device 74 **is used** for **all** transactions, because device 74 is involved in **every** transaction to check for both (1) a previous incentive credit and (2) an incentive credit generated by the present transaction. Therefore, **every offline purchase is transacted with customer device 74**, regardless of whether or not there is a previous incentive credit stored in device 74. Therefore, Biorge does not disclose "wherein said offline purchase was not transacted with the first computer", as recited in claim 1.

In the summary of the invention section, Biorge column 2 line 44 through page 3 line 6 states that:

In the system of the present invention, each of the devices preferably cooperates with the other devices to carry out the method of the present invention. That is, the various devices operate interactively to carry out an overall process. By operating in this manner, the individual requirements of each of the parties can be taken into account.

In accordance with the method of the present invention, incentive credits

are allocated and redeemed by first conducting a transaction between a customer and a provider. From this transaction, a transaction amount is derived. After the transaction amount is derived, an incentive credit total stored in the customer device (74) is checked to determine whether it has a zero value. If so, the customer has no incentive credits to redeem. However, if incentive credits are stored on the customer device (74), the customer is asked whether he wishes to redeem any of the accrued incentive credits, and if so, how many. Where an affirmative response is received, a specified number of incentive credits are redeemed to lower the transaction amount by a discounted amount [sic] The number of incentive credits redeemed is subtracted from the incentive credit total stored in the customer device (74) to update this total. Thereafter, the number of incentive credits earned in the present transaction is computed along with the credit incentives offered by additional providers to derive an incentive credit amount. This incentive credit amount is added to the incentive credit total stored in the customer device (74) to again update the total. The newly earned incentive credits may be redeemed in a future transaction. Incentive credits are thus allocated and redeemed in accordance with the present invention.

The “devices” include a customer-carried portable device 74, which is a smart card (Biorge column 8 lines 29-31), a provider device 76, which also is a portable smart card (Biorge column 8 lines 45-46), and a base device 72, which coordinates the interaction of 74 and 76 and provides a complete environment in which consumer/provider transactions may be conducted at the point of sale terminal (Biorge column 8 line 66 through column 9 line 30). See also Biorge figure 3.

Furthermore, Biorge column 5 lines 17-49, with emphasis supplied, states that:

After the devices and user are verified to be valid, an off-line transaction between the customer and the provider can commence. **At this point, all applicable files stored on the customer device are opened for the purpose of**

**processing and computing incentive credits.** The transaction may be a purchase of a good or a service from the provider. From this transaction, a transaction amount is derived 22. Based on the transaction amount, and perhaps some other criteria such as the level of participation by multiple providers, the number of monthly transactions, and other programmable options, an incentive credit amount is computed 24. The incentive credit amount represents the amount of credits to be allocated to the customer from the present purchase. This incentive credit amount is not applicable to the present transaction but may be redeemed only in a future purchase. Thus, the customer has an incentive to enter into a future transaction with the same or another participating provider.

The process of computing the incentive credit amount is a multi-step process. First, based on the transaction, an incentive code is derived from the base device. This incentive code is processed with an incentive program code stored within the provider device and a customer incentive code stored within the customer device to derive an incentive rate. Optionally, additional provider codes, which maybe stored in the customer device and/or the base device, may be used to compute an augmented incentive rate which gives the customer an even greater discount. Thereafter, the incentive rate or the augmented incentive rate is applied to the transaction amount to derive the incentive credit amount. **Note that all three devices participate in the computation process. Computing the incentive credit amount in this manner allows the specific needs of each of the parties to be taken into consideration.**

Biorge column 5 lines 17-49 discloses that customer device 74 is involved in the transaction to check for both (1) a previous incentive credit and (2) an incentive credit generated by the present transaction. Therefore, **every said offline purchase is transacted with customer device 74**, regardless of whether or not there is a previous incentive credit. This disproves the examiner's assertion that:

[W]hen the only credits available are presently accrued credits, the first computer is not used to transact the purchase. [Office action mailed February 27, 2006 page 3 lines 4-5.]

Thus, even when the only credits available are presently accrued credits, customer device 74 **is used** to transact the purchase because the presently accrued credits are computed using the customer device (Biorge column 5 lines 34-39) and stored in the customer device.

As Biorge does not disclose “wherein said offline purchase was not transacted with the first computer”, as recited in claim 1, the rejection of claim 1 is improper and should be reversed.

3. **The Examiner’s Rejection of Claim 1 is Improper because there is no Motivation to Combine Biorge and Stein to Overcome the Examiner’s Admission that “Biorge et al. does not teach [that] the first identifier is associated by a purchase behavior classification with the observed purchase history of a customer”**

In support of the rejection of claim 1, the examiner stated that:

6. Biorge et al. does not teach that the first identifier is associated by a purchase behavior classification with the observed purchase history of a consumer. Stein et al. teaches that the first identifier (user code, col. 2 lines 65-66) is associated by a purchase behavior classification with the observed purchase history of a consumer. Because classification is statistically efficient, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stein et al. to those of Biorge et al. [Office action mailed February 27, 2006 page 3 lines 6-12; emphasis supplied in the original.]

The examiner relies upon Stein to suggest modifying Biorge to “associate a purchase behavior classification with the observed purchase history of a consumer”, relying upon Stein’s disclosure at column 2 lines 65-66. The applicant submits that the examiner intended to rely

upon Stein column 2 line 66 to column 3 line 8, wherein Stein discloses classifying use information based upon use of at least one product into classified information. Stein column 2 line 66 to column 3 line 8 states that:

A user code is provided to the prospective user. The user code is entered into a data processing means. The user code is correlated with the user information and the use information. The user information and the use information is classified based on use of the at least one product, into classified information. At least one class of information is identified as potentially relevant to future purchases. Product picks are identified and delivered based on the classified information and the user information, responsive to an inquiry on behalf of the user.

However, the purpose of Biorge is unrelated to classification; it relates only to credit information. Stein teaches classifying a user's use information to select product picks for the users. Stein provides no motivation to modify Biorge to somehow include generating classification information because classification information is irrelevant to Biorge's purpose of accounting for credit. Moreover, the examiner has provided no reasoning explaining (1) how Biorge's credit information in Biorge's hand-held device could be classified or (2) a motivation in the prior art suggesting why the credit information in Biorge's hand-held device should be classified.

As there is no motivation to modify Biorge's hand-held device based upon Stein, the rejection of claim 1 is improper and should be reversed.

4. **The Examiner's Rejection of Claim 1 is Improper because there is no Motivation to Combine Biorge and Herz to Overcome the Examiner's Admission that "Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history"**

In further support of the rejection of claim 1, the examiner stated that:

7. Biorge et al. does not teach that said selecting is made without providing to an advertiser said purchase history. Because Herz et al. teaches (col. 5 lines 34-43) that there is need to maintain confidentiality of the purchase history data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make said selecting without providing to an advertiser said purchase history. [Office action mailed February 27, 2006 page 3 lines 13-17.

In response, the applicant asserts that the relevant limitation in claim 1 recites, with emphasis supplied:

“selecting and electronically delivering the targeted advertisement to the consumer at the first computer in response to receiving the first identifier from the first computer, said selecting based on said purchase behavior classification **without providing to an advertiser any of said purchase history information**”

There is no motivation to combine Biorge and Herz to make obvious the limitation in claim 1:

“selecting and electronically delivering the targeted advertisement to the consumer at the first computer in response to receiving the first identifier from the first computer, said selecting based on said purchase behavior classification without providing to an advertiser any of said purchase history information”

because Biorge teaches away from disclosing not providing customer information to an advertiser.

Biorge column 5 lines 17-21 states that:

After the devices and user are verified to be valid, an off-line transaction

between the customer and the provider can commence. At this point, all applicable files stored on the customer device are opened for the purpose of processing and computing incentive credits.

Biorge column 5 lines 46-49 states that:

Note that all three devices participate in the computation process. Computing the incentive credit amount in this manner allows the specific needs of each of the parties to be taken into consideration.

Biorge specifically discloses opening all applicable files stored on the customer device and **providing the information to the advertiser in order to meet the specific needs of the advertiser**. Therefore, Biorge teaches away from the recitation “said selecting is made without providing to an advertiser said purchase history”.

Moreover, it would not have been obvious to modify Biorge in view of Herz in the manner asserted by the examiner.

Biorge is a system directed to allocating and redeeming incentive credits between a portable device and a base device. See the abstract. Biorge does not disclose or suggest categorizing a consumer based upon product selections.

In contrast, Herz is directed to delivering product offers to a customer similar to the customer’s prior product selections. See the abstract.

The purposes for Biorge’s and Herz’s process are unrelated. Therefore, they provide no motivation to modify one in view of the other. Moreover, the examiner’s motivation for combining the two references is “to maintain confidentiality of the purchase history data”. However, since Biorge discloses freely providing sensitive consumer information to the advertisers (see Biorge column 5 lines 17-21 and Biorge column 5 lines 46-49, both cited above), the examiner’s stated motivation to combine Biorge and Herz is not tenable. Therefore, for all of the reasons presented above, the rejection of claim 1 is improper and should be reversed.



5. **The Examiner's Rejections of Independent Claims 55, 86, and 87 are Improper because there is no Motivation to Combine Stein and Merriman to Overcome the Examiner's Admission that "Stein et al. does not teach that said consumer computer is at the consumer's home or office"**

In support of the 35 USC 103(a) rejections of independent claims 55, 86, and 87 as obvious over Stein in view of Merriman, the examiner stated that:

12. Stein et al. teaches (independent claims 55, 86 and 87) a computer network implemented method and system for delivering targeted advertisements, the method comprising: collecting a first consumer/customer/user offline purchase history and identification (col. 2 lines 42-43 and 65-66); storing said consumer/customer/user information (col. 4 lines 14-19); (inherently) receiving from *kiosk 5* its network address, which reads on a "consumer computer first identifier", sending said kiosk network address with the *user code*/first consumer identification to the *coupon controller 9*, which reads on associating said first identifier/kiosk network address with said first consumer identification/*user code*, and determining a targeted advertisement (*targeted promotions*, col. 1 lines 10-12 and *announcements*, col. 4 lines 60-61) for said first consumer based at least in part on said offline purchase history associated with said first consumer identification/*user code* with said first identifier/*kiosk 5* its network address (col. 6 lines 28-51); and delivering said determined targeted advertisement to said first consumer (col. 6 lines 55-57).

13. Stein et al. does not teach that said consumer computer is at the consumer's home or office. Merriman et al. teaches a PDA 16 (col. 3 lines 23-27), which reads on a consumer computer at the consumer's home or office. Because Stein et al. teaches that it is important to keep consumers/*users* from monopolizing a *kiosk 5* consumer computer (col. 6 line 59), it would have been

obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Merriman et al. to those of Stein et al. Stein et al. teaches a local area network (*Ethernet*, col. 6 line 40) joining the *kiosk 5* consumer computers in each store (col. 5 lines 9-12) with ad/coupon controller 9 (col. 6 lines 37-45).

Merriman et al. teaches a broader Internet (col. 1 line 30) connecting any number of consumer computers *PDA 16* to *ad server 19*. Because it would enhance consumer convenience and minimize the number of special and *kiosk 5* consumer computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to replace at least some of the *kiosk 5* consumer computers with the *PDA 16* consumer computers accessing coupons/ads over the Internet. [Office action mailed February 27, 2006 page 4 line 13 through page 5 line 7.]

In response, the applicant emphasizes that the examiner's stated motivation for adding Merriman's PDA to Stein is because it is "important to keep consumers/users from monopolizing a kiosk". Office action mailed February 27, 2006 page 4 lines 29-30. The examiner's assertion is a stretch because Stein explicitly discloses keeping consumers from monopolizing a kiosk. Stein column 6 lines 59-65 states that:

To prevent a user from monopolizing a kiosk 5, the coupon controller 9 may suppress the transmission to the printer 7 until after a certain time delay, or after a predetermined number of transactions. Also, the coupon controller 9 may suppress the transmission to the printer 3 until after a time delay to prevent the user from obtaining a second coupon during one visit to a store location.

Moreover, the applicant respectfully questions the examiner's logic in his conclusions that **eliminating** some of the kiosks would be useful, and that the prior art provides a motivation to do that:

Because it would enhance consumer convenience and minimize the

number of special and *kiosk* 5 consumer computers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to replace at least some of the *kiosk* 5 consumer computers with the *PDA* 16 consumer computers accessing coupons/ads over the Internet. [Office action mailed February 27, 2006 page 5 lines 4-7.]

Stein already discloses sufficient procedures for eliminating the monopolization of kiosks and the examiner's proposal for eliminating the monopolization of kiosks is illogical. Thus, the examiner has not presented a proper motivation to combine Stein and Merriman.

In addition, Stein and Merriman's systems are not comparable because their local and wide area networks are not interchangeable. Stein discloses a "method and system for delivering on demand, individually targeted promotions and recommendations coupons." Stein column 1 lines 10-12. This is accomplished using a **local ethernet** system (Stein column 6 line 40) physically located at a retail store, except for host storage 15 and host system 13, which communicates once daily with point-of-sale computer 11 via a dial-up connection. Representative of the local scope of the network in Stein, column 5 lines 59-63 states that:

The coupon controller 9 maintains a customer history file based on real-time transactions monitored by the point-of-sale computer 11. Thus, a coupon controller 9 in a particular store need only store information for that store location, and for individuals which use that store location.

In contrast, Merriman discloses "methods of delivery of advertisements and measuring responses to those delivered advertisements and in particular relates to the targeting of advertisements delivered over networks such as the Internet." Merriman column 1 lines 8-11.

Moreover, Stein does not disclose the consumer being situated outside the retail store during the transaction. Stein column 2 lines 33-35 states that:

It is another object of the invention to provide these picks at the check-out

stand or at a kiosk, where selections are made.

Therefore, the examiner's assertion that the teachings of Merriman could be combined with Stein to disclose a consumer computer located **outside** the retail store, for example, at either the consumer's home or the consumer's office, as defined in claims 55, 86, and 87, is without merit.

Furthermore, Stein discloses delivering its product recommendations and promotions in **real-time**. Column 2 lines 25-27. However, Stein does not disclose the capacity to process off-site communications concurrently with a real-time transaction, as evidenced by the off-site host system 13 receiving current customer and inventory information only once per day. Therefore, it would not be obvious to combine Stein's network to include the PDA disclosed by Merriman, as Stein does not disclose real-time remote processing.

For all of the reasons presented above, there is no motivation to combine Stein and Merriman to overcome the examiner's admission that "Stein et al. does not teach that said consumer computer is at the consumer's home or office". Therefore, the rejections of independent claims 55, 86, and 87, and the claims depending therefrom, are improper and should be reversed.

**6. The Examiner's Rejections of Claims 64-67 are Improper because Stein does not Teach an Advertiser's Server or an Association Table as Defined in the Specification and the Examiner has not Presented a Prima Facie Case for the Rejections of Claims 65-67**

In support of the rejections of claims 64-67, the examiner stated that:

14. Stein et al. also teaches at the citations given above claims 59 (inherently), 64 (where coupon controller 9 reads on an advertiser's server) and 65-67.

15. Applicant argues (pp. 21 last line) that claims 64 is not taught by Stein et al., because the reference does not teach an advertiser's server as defined in the

specification and that claim 65 is not taught (p. 22 first full para.).

16. Note on interpretation of claim terms Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention [sic], but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ..."

17. The instant application contains no such clear definition for any terms, including "advertiser's server". In the instant case, the examiner is required to give this term its broadest reasonable interpretation, which is any server of ads. *Coupon controller* 9 taught by Stein et al. (col. 6 lines 37-54) reads on that. For claim 65, by the same logic, any mechanism that associates identifiers with corresponding consumer identifications is an association table. [Office action mailed February 27, 2006 page 5 lines 8-27.]

In response, with respect to claim 64, the applicants submit that the coupon controller defined in Stein does not read on an advertiser's server as disclosed in the subject application. The subject application defines an advertiser's server as a device that sends a cookie to a client computer system. When the client computer system accesses certain Web sites, the client system automatically transmits a copy of the cookie that the advertiser's server can use to identify the client system and send customized content. Page 2 line 23 through page 3 line 3.

In contrast, Stein discloses that the user must input a user code in order for the coupon controller to be able to base coupon selections on the individual user. See, for example, Stein column 6 lines 46-51, which states that:

The kiosk 5 will begin the process when the user code is entered. As with the check-out terminals, the user code can be entered via the scanable card 19, or entered manually. The entry of the user code will permit the coupon controller 9 to correlate the user code to the stored user information, and thus to base selections on the individual user.

Since the coupon controller in Stein does not send a cookie to a client computer system, it is not an advertiser's server, as defined in the subject application. Moreover, Stein's computer controller is not able to identify the consumer (without the consumer entering a user code) in order to send customized content, coupon controller does not read on an advertiser's server. For these additional reasons, the rejection of claim 64 is improper and should be reversed.

Furthermore, the examiner has not presented a prima facie case for the rejection of claim 65; there is no showing of the association table defined by claim 65. In addition, the examiner has not presented a prima facie case for the rejections of claims 66 and 67. For these additional reasons, the rejections of claims 65-67 are improper and should be reversed.

**7. The Examiner's Assertions that Claimed Terms Advertiser's Server and Association Table are not Expressly Defined in the Specification are Incorrect**

The examiner's assertion at page 5 lines 13-27 in the office action mailed February 27, 2006 is copied above. In response, the applicant submits that on page 12 line 16 through page 13 line 7, the specification defines "association table" as the following:

Figure 3 illustrates an association table 40 for storing information that associates a computer with a particular consumer and master record. The association table 40 may be implemented as a data structure including a list 42 of first identifiers linked to a list 44 of second identifiers. As shown, the list 42 is a list of cookie numbers. Each cookie number corresponds to a cookie that has been sent to a computer as a result of a consumer registering online with the registration server 14 (described below with reference to Figure 7). Accordingly,

each cookie number identifies a single Web browser run on a computer that was used by a consumer to register. The list 44 is a list of CIDs, each of which corresponds or is linked to the adjacent cookie number in the list 42. Each CID in the list 44 is also stored in the purchase history database 8 in a master record. Thus, the association table 40 links a Web browser (via the cookie number) with a master record (via the CID) for a consumer who used the Web browser to register online. The association table 40 may be stored in the registration server 14 or any other suitable stored device including any of the devices shown in Figure 1 (e.g., the registration server 18). As technology progresses, cookies may become associated with individuals and not directly correspond to a Web browser, and the invention includes the use of identification methods other than conventional cookies.

The association table 40 may contain additional lists and/or fields. For example, it may be desirable for the association table 40 to include a field that identifies the association table 40 if multiple association tables are generated and stored. Preferably, the association table 40 stores at least one list of identifiers which are also stored in the purchase history database 8 and which identify registered consumers.

On page 10 lines 17-25, the specification defines “advertiser’s server” as the following:

The advertiser’s server 18 may be a Web server programmed to send and receive registration information to and from a remote computer such as the first computer 10. The advertiser’s server 18 may also be programmed to exchange information with the registration server 14, to associate a remote computer with one or more registered consumers, and to deliver targeted advertisements over the Internet to remote computers such as the first and second computers 10, 12. Different types of targeted advertisements, include Internet banners, real time moving videos, video information, animation information, audio information,

online interstitial advertisements, electronic mailings (e-mails), interactive television advertisements, and any other type of message, recording, and/or display.

Hence, the examiner is incorrect in his assertion that the instant application contains no such clear definition for any terms, including “advertiser’s server”.

**8. The Examiner’s Rejections of Claims 73 and 74 are Improper because Merriman’s User Response to an Ad does not Read on Registration**

In support of the rejections of claims 73 and 74, the examiner stated, without basis, that:

19. Merriman et al. also teaches claims . . . 73 and 74 (col. 7 lines 15-31, where the user response to an ad reads on registration). [Office action mailed February 27, 2006 page 5 lines 30-31.]

Merriman column 7 lines 15-31 states that:

If the user then decides that he wants to respond to the advertisement and then clicks on the advertisement, the advertisement server 19 receives an HTTP request 23 for a click through which it will recognize by receiving the same IP address (and optionally, the user ID specified by the cookie, digital signature or certificate or log in identification) in the request from the same affiliate's web page within a predetermined period. Since the advertisement server previously recorded which advertisement was sent to that IP address, it sends the redirect message causing the user's browser to receive the URL for the advertiser's web site based upon data stored in the server. In addition, the server logs that the advertisement was clicked through, which user selected the advertisement based upon the IP address, and the page on which the advertisement was seen based upon the click through. This information can then be logged in later reporting



processes 59.

Neither this passage, nor any passage in Merriman discloses “online registration”, as recited in claim 73 or sending a cookie “from said advertiser’s server to a registration server”, as recited in claim 74. Merriman discloses gathering information about individual users when users select different advertisements (column 2 lines 9-10), but Merriman’s disclosure of what amounts to **eavesdropping** to cull information about a consumer does not make obvious the limitations of claims 73 and 74 recited above.

The subject application discloses online registration at page 17 lines 1-11 which states that:

In step 60, the consumer’s Web browser jumps to a registration Web page served by the registration server 14. Then, in step 62, the consumer registers online with the registration server 14 and, in the process, provides the registration server with information, including an identifier found in the master record 30 (e.g., the consumer’s CID). The consumer may supply the registration server 14r with information about the consumer to generate an online profile for the consumer. The online profile may include information such as the consumer’s name CID, e-mail address, product/brand preferences, demographic information, work address, home address, whether the consumer has any babies, and whether the consumer has any pets such as a cat, dog, bird, or fish.

In addition, the subject application discloses sending a cookie from an advertiser’s server to a registration server at page 17 lines 20-22.

The examiner’s admission that Merriman does not teach sending a registration web page (office action mailed February 27, 2006 page 6 lines 3-4) further support the applicant’s assertion that Merriman does not disclose online registration.

For the reasons presented above, the rejections of claims 73 and 74 are improper and should be reversed.

9. **The Examiner's Taking of Official Notice Regarding the Obviousness Rejections of Claims 57, 58, 60, 61, 71, and 75-85 is Improper because the Examiner has not Presented a Prima Facie Rejection of Obviousness for Claims 57, 58, 60, 61, 71, and 75-85**

In support of the rejections of claims 57, 58, 60, 61, 71, and 75-85, the examiner stated that:

20. Neither Stein et al. nor Merriman et al. teaches the purchase history data limitations of claims 57, 58, 60 and 61, IVR (claim 71) or sending a registration web page (claims 75-85). Official notice was taken (para. 15 of the Office action mailed on 6 June 2005) that all of the purchase history data limitations were commonly acquired and are of clear use to a retailer for product promotion, and also that IVR communication and web page registration were common at the time of the invention.

21. Traverse of the taking of Official Notice - On pp. 23-24, applicant has traversed the examiner's taking of official notice (para. 20 above). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained. [Office action mailed February 27, 2006 page 6 lines 3-14.]

In response, the applicants reiterate that in the response filed November 18, 2005 at page 23 line 20 through page 24 line 21, the applicants argued that the examiner did not address the fact that neither Stein nor the examiner's official notice suggest modifying Stein to include (1)

the limitations of “said first consumer offline purchase history,” as defined by claims 57, 58, 60, and 61; (2) “exchanging information between [an] IVR provider and said analytical computer system; providing an IVR message to said first consumer from said IVR provider,” as defined by claim 71; or (3) the limitations regarding registration at a web page, as defined by claims 75-83.

MPEP 706.02(j) Contents of a 35 USC 103 Rejection states in pertinent part that:

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Since the examiner has not met his burden in establishing a prima facie case of obviousness, the rejections of claims 57, 58, 60, 61, 71, and 75-85 are improper and should be reversed.

Moreover, the examiner has not met his burden regarding the taking of official notice. MPEP 2144.03B. states in pertinent part that:

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See Lee, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

\* \* \*

If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on

sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

The applicant asserts that the examiner has not produced authority for his statement of taking official notice; and that the examiner has not addressed the requirements of MPEP 2144.03B., copied above.

**10. The Examiner's Rejection of Claim 70 is Improper because there is no Motivation to Combine De Lapa with Stein and Merriman to Overcome the Examiner's Admission that "Neither Stein nor Merriman teaches transmitting offline purchase history data in real time"**

In support of the rejection of claim 70, the examiner stated that:

Neither Stein et al. nor Merriman et al. teaches transmitting offline purchase history data in real time. De Lapa et al. teaches transmitting offline purchase history data in real time (*dynamically updated*, col. 9 lines 39-45). Because De Lapa et al. teaches that dynamic/real time updating enables greater profits (col. 3 lines 18-22), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of De Lapa et al. to those of Stein et al. and Merriman et al. [Office action mailed February 27, 2006 page 6 lines 17-22.]

In response, the applicant asserts that enabling greater profits is not a proper motivation to combine references for an obviousness rejection because it does not relate to the teachings of the

reference and motivation to combine those teachings. The court in Sensonic, Inc. v. Aerosonic Corp. constructively proscribes this approach to examination, stating that:

As this court has stated, “virtually all [inventions] are combinations of old elements.” Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (“Most, if not all, inventions are combinations and mostly of old elements.”). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Therefore, as the examiner has not provided a proper motivation to combine De Lapa with Stein and Merriman to Overcome the Examiner’s Admission that “Neither Stein nor Merriman teaches transmitting offline purchase history data in real time,” the rejection of claim 70 is improper and should be reversed.

Moreover, Stein’s offsite host system 13 discloses dialing up the point-of-sale computer 11 once per day and therefore, is not compatible with and furthermore, teaches away from the recitation in claim 70 of “transmitting said first consumer offline purchase history data for said offline purchase transaction from a retail store where said offline purchase transaction occurs to [said analytical computer system not located in said retail store] in real time.” For this additional reason, the rejection of claim 70 is improper and should be reversed.

**H. 37 CFR 41.37 (c)(1)(viii) Claims Appendix**

An appendix containing a copy of the claims involved in the appeal is attached as Appendix I.

**I. 37 CFR 41.37 (c)(1)(ix) Evidence Appendix**

There is no evidence submitted pursuant to 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal.

**J. 37 CFR 41.37 (c)(1)(x) Related Proceedings Appendix**

There are no related proceedings. Therefore, this section is inapplicable.

**IV. 37 CFR 47.37 (c)(2)**

This brief does not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence.

**V. 37 CFR 41.37 (d)**

This brief is in compliance with the requirements of paragraph (c) of this section. Accordingly, this section is inapplicable.

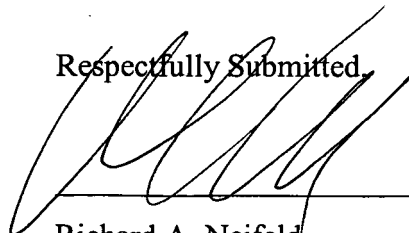
**VI. 37 CFR 41.37 (e)**

The filing of this appeal is timely.

5/30/06

DATE

Respectfully Submitted,



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Attorney of Record

DHS/BTM

Printed: May 30, 2006 (3:19pm)

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## APPENDIX I

Claim 1: A method for delivering a targeted advertisement, comprising:

receiving from a first computer a first identifier identifying the first computer and associated by a purchase behavior classification with an observed offline purchase history of a consumer, said purchase history including purchase history information of an offline purchase of a consumer collected when the offline purchase transpired; and

selecting and electronically delivering the targeted advertisement to the consumer at the first computer in response to receiving the first identifier from the first computer, said selecting based on said purchase behavior classification without providing to an advertiser any of said purchase history information,

wherein said offline purchase was not transacted with the first computer.

Claim 55: A computer network implemented method for delivering targeted advertisements, comprising:

collecting, during an offline purchase transaction of a first consumer at a point of sale terminal in a retail store, a first consumer offline purchase history data and a first customer identification for said first consumer;

storing said first consumer offline purchase history data in association with said first consumer identification;

receiving from a consumer computer a first identifier;

associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data;

determining a targeted advertisement for said first consumer based at least in part on said offline purchase history associated via said first consumer identification with said first identifier;

delivering said determined targeted advertisement to said first consumer via said consumer computer;

wherein said consumer computer is at least one of a computer at said first consumer's home and a computer at said first consumer's office; and

wherein said consumer computer is not at said point of sale terminal.

Claim 56: Canceled.

Claim 57: The method of claim 55, wherein said first consumer offline purchase history data includes a SKU of an item purchased.

Claim 58: The method of claim 55, wherein said first consumer offline purchase history data includes a UPC of an item purchased.

Claim 59: The method of claim 55, wherein said first consumer offline purchase history data includes store location of a store in which said offline purchase transaction occurs.

Claim 60: The method of claim 55, wherein said first consumer offline purchase history data includes price of an item purchased.

Claim 61: The method of claim 55, wherein said first consumer offline purchase history data includes date of said offline purchase transaction.

Claim 62: The method of claim 55, wherein said storing comprises storing said offline purchase data electronically in a retail store where said offline purchase transaction occurs.

Claim 63: The method of claim 55, wherein said first identifier comprises a value corresponding to a cookie.

Claim 64: The method of claim 55, wherein said receiving comprises receiving said first identifier at an advertiser's server.

Claim 65: The method of claim 55, wherein said associating said first identifier with said



first consumer identification comprises using an association table that associates identifiers with corresponding consumer identifications.

Claim 66: The method of claim 55, wherein said delivering comprises transmitting said targeted advertisement to said consumer computer.

Claim 67: The method of claim 55, wherein said determining comprises analyzing said first consumer offline purchase history data with an analytics unit of an analytical computer system.

Claim 68: The method of claim 55, wherein said offline purchase transaction occurs in a retail store and further comprising transmitting said first consumer offline purchase history data from said retail store to said analytical computer system, said analytical computer system not located in said retail store.

Claim 69: The method of claim 68, wherein said analytical computer system maintains an offline purchase history database storing therein offline purchase transaction data from transactions in multiple retail stores and from multiple consumers.

Claim 70: The method of claim 68, further comprising transmitting said first consumer offline purchase history data for said offline purchase transaction from a retail store where said offline purchase transaction occurs to said analytical computer system in real time.

Claim 71: The method of claim 68, further comprising:  
exchanging information between and IVR provider and said analytical computer system;  
providing an IVR message to said first consumer from said IVR provider; and  
playing said IVR message to said first consumer.

Claim 72: The method of claim 68, further comprising:

transmitting a request for data to an advertiser's server from said consumer computer.

Claim 73: The method of claim 72, further comprising:

initiating online registration by entering data on a web page hosted by an advertiser's server.

Claim 74: The method of claim 73, further comprising:

sending a cookie having a cookie value from said advertiser's server to said consumer computer;

storing said cookie having said cookie value in said advertiser's server and also storing said cookie having said cookie value in said consumer computer; and

sending said cookie having said cookie value from said advertiser's server to a registration server.

Claim 75: The method of claim 74 further comprising:

sending a registration web page hosted by said registration server from said registration server to said consumer computer.

Claim 76: The method of claim 75, further comprising:

transmitting registration information from said consumer computer to said registration server, wherein said registration information comprises said first consumer identification.

Claim 77: The method of claim 76, further comprising:

transmitting from said advertiser's server to said registration server said cookie having said cookie value;

transmitting from said first computer to said registration server said first consumer identification;

storing in said registration server said cookie having said cookie value transmitted from said advertiser's server and said first consumer identification transmitted from said consumer

computer; and

associating said first consumer identification for said first consumer with said cookie value for said first consumer by lookup in a lookup table wherein consumer identifications are associated with cookie values.

Claim 78: The method of claim 77 further comprising:

transmitting from said advertiser's server to said registration server selected purchase behavior criteria and a list of cookie values corresponding to consumers who have registered through said advertiser's server.

Claim 79: The method of claim 78 further comprising:

generating in said registration server a list of consumer identifications corresponding to said cookie values received from said advertiser's server.

Claim 80: The method of claim 79 further comprising:

transmitting from said registration server to said analytics computer system said selected purchase behavior criteria and said consumer identifications generated from said registration server.

Claim 81: The method of claim 80 further comprising:

analyzing in said analytics computer system said offline purchase transaction data to determine which customers fit said purchase behavior criteria.

Claim 82: The method of claim 81 further comprising:

transmitting from said analytics computer system to said registration server targeted advertisement data for consumers who have registered through said advertiser's server.

Claim 83: The method of claim 82 further comprising:

modifying said targeted advertisement data received from said analytics unit computer

system, by replacing consumer identifications associated with a targeted advertisement data with a corresponding cookie value.

Claim 84: The method of claim 83 further comprising:

sending from said registration server said modified targeted advertisement profile to said advertiser's server.

Claim 85: The method of claim 80 wherein said delivering comprises transmitting said targeted advertisement from said advertiser's computer to said consumer computer.

Claim 86: A computer network system for delivering targeted advertisements, comprising:

structure for collecting, during an offline purchase transaction of a first consumer at a point of sale terminal in a retail store, a first consumer offline purchase history data and a first customer identification for said first consumer;

structure for storing said first consumer offline purchase history data in association with said first consumer identification;

structure for receiving from a consumer computer a first identifier;

structure for associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data;

structure for determining a targeted advertisement for said first consumer based at least in part on said offline purchase history associated via said first consumer identification with said first identifier;

structure for delivering said determined targeted advertisement to said first consumer via said consumer computer;

wherein said consumer computer is at least one of a computer at said first consumer's home and a computer at said first consumer's office; and

wherein said consumer computer is not at said point of sale terminal.

Claim 87: A computer network system for delivering targeted advertisements, comprising:

means for collecting, during an offline purchase transaction of a first consumer at a point of sale terminal in a retail store, a first consumer offline purchase history data and a first customer identification for said first consumer;

means for storing said first consumer offline purchase history data in association with said first consumer identification;

means for receiving from a consumer computer a first identifier;

means for associating said first identifier with said first consumer identification which is associated with said first consumer offline purchase history data;

means for determining a targeted advertisement for said first consumer based at least in part on said offline purchase history associated via said first consumer identification with said first identifier;

means for delivering said determined targeted advertisement to said first consumer via said consumer computer;

wherein said consumer computer is at least one of a computer at said first consumer's home and a computer at said first consumer's office; and

wherein said consumer computer is not at said point of sale terminal.

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Printed: May 30, 2006 (3:19pm)

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